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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/902,749	07/12/2001	Robert Noodelijk	28967.0112	9603

7590 11/29/2006

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EXAMINER

HWU, JUNE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/902,749

Applicant(s)

NOODELIJK, ROBERT

Examiner

June Hwu

Art Unit

1661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Applicant remarks filed October 13, 2006 is acknowledged and entered.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by the Dutch Plant Breeder's Right (PBR) application number CHR3121 published on June 16, 1999, more than one year prior to the filing date of the instant application in view of Applicant's admission that the instant cultivar was first sold in the Netherlands on January 1999 (reply dated December 13, 2002, page 2) and also noted in the Plant Varieties Journal vol. 17, no. 1, 2004 that the first sale occurred in the Netherlands on January 15, 1999, and further in view of the Royal Horticultural Society Dictionary of Gardening 1992, vol. 1 (pages 614-617) describing how to asexually propagate a chrysanthemum.

Claim 1 remains rejected under 35 U.S.C. 102(b) as being anticipated by the Polish PBR application number OO00739 published on March 31, 2000, more than one year prior to the filing date of the instant application in view of Applicant's admission that the instant cultivar was first sold in the Netherlands on January 1999 (reply dated December 13, 2002, page 2) and also noted in the Plant Varieties Journal vol. 17, no. 1, 2004 that the first sale occurred in the Netherlands on January 15, 1999 (p. 309), and further in view of the Royal Horticultural Society

Art Unit: 1661

Dictionary Gardening 1992, vol. 1 (pages 614-617) describing how to asexually propagate a chrysanthemum.

Response to Arguments

Applicant's arguments filed October 13, 2006 have been fully considered but they are not persuasive.

Applicant argues that the cited publications (Dutch PBR CHR3121 and Polish PBR OO00739) do not publish the name of the instant variety, 'Sunny Elite Reagan', until June 16, 2001 in the Netherlands and until June 30, 2001 in Poland, less than one year prior to the filing date of this instant plant application. The PBR publications cite only the breeder's reference number (pp. 2 and 3 of reply).

This argument has not been found persuasive because a name change would not have any effect to the sale of the plant because the instant plant was in the public domain and one of the ordinary skill in the art could have obtain and reproduce the plant as early as January 1999, more than one year prior to the filing date of this instant plant application. Moreover, the UPOV-rom Plant Variety Database (see Exhibits A and B) lists the breeder and assignee names. One of ordinary skill in the art could have search the Internet for the breeder's name "Chrysanthemum Breeders Association" (see UPOVROM Plant Variety Database 2005/05 and Exhibits A and B) at <<http://www.cba-nv.nl/index.cfm?act=Contact.formulier>>. By clicking on "Contact", one of ordinary skill could have contacted Chrysanthemum Breeders Association by mail, telephone, fax or e-mail concerning the plant availability and/or where to purchase the plant. One cannot overlook the fact that when contacted by one of the ordinary skill in the art, the breeder, eager to sell, would indicate to the former that the plant is available under a different name. It is clear that a difference in names does not obscure the fact that one of

Art Unit: 1661

ordinary skill in the art could have purchase the plant, as the sale was not a single, isolated occurrence, that would have gone unnoticed.

Applicant argues that the cited publication do not disclose breeding history of how the instant variety was made (pp. 2-3 of reply).

This argument has not been found persuasive because the breeding history of how the instant variety was made has no bearing to the fact that the instant plant was disclosed in PBR applications and the instant plant was available to the public more than one year prior to the filing date of this application and a person skilled in the art could obtain and asexually reproduce the instant plant since chrysanthemum propagation is well documented in the art as noted in the Royal Horticultural Society Dictionary of Gardening (pp. 614-617).

Applicant argues that there is no information in the Dutch and Polish PBR applications linking the breeder's reference number to the PBR applications to the plants sold outside the U.S. under the name 'Sunny Elite Reagan' (p. 4 of reply).

This argument has not been found persuasive because as stated above the breeder's reference number is immaterial to the evidence that the instant plant was accessible to the public and the published PBR applications were publicly available more than one year prior to the filing date of this application and the reproducibility of the plant as described in the Royal Horticultural Society Dictionary of Gardening reference.

Applicant reiterates that the foreign sale in January 1999 of the instant cultivar was made under the plant's official name 'Sunny Elite Reagan' and not its breeder's reference number (p. 4 of reply).

This argument has not been found persuasive because as stated above the name difference is irrelevant.

Art Unit: 1661

Applicant finally argues that the facts in *In re Elsner*, 72 USPQ2d 1038 (CA FC 2004) were different from this instant application in which the name in the PBR application is the same as cited in the "provisional denomination" and in this case there is no evidence that one of ordinary skill in the art could have linked the breeder's reference number to 'Sunny Elite Reagan' (pp. 4-5 of reply).

This argument has not been found persuasive because as stated above the difference is irrelevant. The issue in *Elsner* is similar to this instant case in that the publication of the PBR applications placed the claimed invention in possession of the public more than one year prior to the filing date of this instant application and the foreign sales of the plants placed the claimed invention in the possession of the public and the reproducibility of the plant is well known in the art would bar patentability under 35 USC 102(b).

For the reasons outlined above and in the previous Office action, the rejection is deemed proper and is maintained.

Conclusion

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

Art Unit: 1661

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:00 a.m. to 4:30 p.m.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Anne Marie Grunberg, can be reached on (571) 272-0975. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**KENT BELL
PRIMARY EXAMINER**

JH

Kent L. Bell